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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/333,534    06/14/99    CONNER    T    38-21(15404)

HM22/0518

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EXAMINER

MARSCHEL, A

ART UNIT

PAPER NUMBER

1631

2

DATE MAILED:

05/18/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/333,534**

Applicant(s)

**Conner et al.**

Examiner

**Ardin Marschel**

Group Art Unit

**1631**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7 \_\_\_\_\_ is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-7 \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because no submission of computer readable form sequences etc. have been received. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action. A complete response to this office action includes compliance with this sequence filing compliance. Failure to comply may result in abandonment of this application.

#### **Restriction/Election Requirement**

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claim 1, drawn to polynucleotides and compositions containing same, classified in Class 536, subclass 23.1. If this group is elected, then the below sequence election requirement also is required.

II. Claim 2, drawn to polypeptides, classified in Class 530, subclass 300 and 350. If this group is elected, then the below sequence election requirement also is required.

III. Claims 3-7, drawn to transformed plants, classified in Class 800, subclass 295. If this group is elected, then the below sequence election requirement also is required.

**Sequence Election Requirement Applicable to All Groups:**

In addition, each Group detailed above reads on patentably distinct sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicants are permitted to elect up to 10 nucleic acid sequences (See MPEP 803.04).

MPEP 803.04 states:

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions with the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq. Nevertheless, to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided sua sponte to partially waive the

requirements of 37 CFR 1.141 et seq. And permit a reasonable number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).

It has been determined that normally 10 sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. In addition to the specifically selected sequences, those sequences which are patentably indistinct from the selected sequences will also be examined. Furthermore, nucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined together.

Examination will be restricted to only the elected sequences.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups (I and III) and Group II are independent inventions because they are directed to different chemical types regarding the critical limitations therein. For Group II the critical feature is a polypeptide; for Groups I and III the critical feature is nucleic acids. It is acknowledged that various processing steps may cause a polypeptide of Group II to be directed as to its synthesis by a polynucleotide of Group

I, however, the completely separate chemical types of the inventions of the nucleic acid and polypeptide Groups supports the undue search burden if both were examined together.

Additionally, polynucleotides and polypeptides have been most commonly, albeit not always, separately characterized and published in the Biochemical literature, thus significantly adding to the search burden if examined together as compared to being searched separately. Also, it is pointed out that processing that may connect two Groups does not prevent them from being viewed as distinct because enough processing can result in producing any composition from any other composition if the processing is not limited as to additions, subtractions, enzyme action, etc. Thus, the Groupings of (I and III) and (II) are independent and/or distinct invention types for restriction purposes.

The inventions of Group I and Group III are related as product and distinct product of a distinct process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acids of Group I can be used in the distinct processes of the making of the invention of Group III, or, alternatively, for screening via nucleic acid binding or

hybridization reactions. Alternatively, the nucleic acids of Group I can be used in antisense therapy which is also a clearly distinct usage of such nucleic acids.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to

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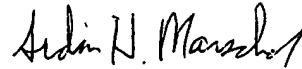
Art Unit: 1631

Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

May 16, 2000

  
**ARDIN H. MARSCHEL**  
**PRIMARY EXAMINER**